

REMARKS

The Office Action dated August 4, 2004 has been received and carefully noted. The period for response having been extended from November 4, 2004 until December 4, 2004 by the attached Petition for Extension of Time, the above amendments to the claims, and the following remarks, are submitted as a full and complete response thereto.

In accordance with the foregoing, claim 5 has been amended to correct a minor informality. No new matter is being presented, and approval and entry are respectfully requested.

Claims 1-12 stand allowed and claims 13-17 stand rejected. Claims 1-17 are pending and under consideration.

REJECTION UNDER 35 U.S.C. § 102:

In the Office Action, at page 2, item numbered 3, claim 13 was rejected under 35 U.S.C. § 102 as being anticipated by U. S. Patent No. 5,613,213 to Naddell et al. ("Naddell"). The Office Action took the position that Naddell describes all the recitations of claim 13. This rejection is traversed and reconsideration is requested.

Independent claim 13, upon which claims 14-15 depend, recites an on-demand-service centre in a mobile communication system including service means for offering at least one service-on-demand to a service area which comprises at least one mobile communication system cell. The on-demand service centre also includes registration means for receiving and acknowledging the registration of a user of the service-on-demand, and billing means responsive to the registration means for charging the user for the use of the service-on-demand.

As will be discussed below, the cited prior art of Naddell fails to disclose or suggest the elements of any of the presently pending claims.

Naddell generally provides a communications system that interprets communication system activity and determines what services are currently available from any RF communication systems within range of the communication unit. See column 2, lines 1-6. The communication unit then displays an indication of the available services for the user to quickly view. However, none of the services provided in Naddell are on-demand-services. Naddell is silent as to providing "an on-demand-service centre in a mobile communication system, comprising: service means for offering at least one service-on-demand," as recited in independent claim 13.

Furthermore, the Office Action correctly recognized that Naddell fails to teach or suggest the recitations of the registration means and billing means recited in independent claim 13. Nonetheless, the Office Action contends that both means are inherent in Naddell's invention. Applicant respectfully traverses such contention. "[W]hen an examiner relies on inherency, it is incumbent on the examiner to point to the 'page and line' of the prior art which justifies an inherency theory." Ex parte Schricker, 56 USPQ2d 1723 (2000).

Specifically, when the Office Action contends that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the prior art. However, the Office Action does not indicate which part of Naddell supports that "the means [registration means and billing means] are inherent in Naddell's invention otherwise the services rendered are not accounted for." It appears that the essence of the contention made in the Office Action to support inherency is that the recitations or teachings provided in the present invention are necessary for Naddell to work. Such contention is improper according to current Patent rules.

In addition, the mere fact that the prior art may be modified in the manner suggested by the Office Action does not make the modification obvious unless the prior art suggested the desirability of the modification. "One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate

the claimed invention." In re Fine, 837 F.2d 1071, 1075, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988).

In view of the foregoing, it is respectfully requested that independent claim 13 and related dependent claims be allowed.

REJECTION UNDER 35 U.S.C. § 103:

In the Office Action, at page 3, item numbered 4, claim 14 was rejected under 35 U.S.C. § 103 as being unpatentable over Naddell and U. S. Patent No. 6,449,721 to Pensak et al. ("Pensak"). The Office Action took the position that Naddell and Pensak disclose all the aspects of claim 14. The rejection is traversed and reconsideration is requested.

Dependent claim 14 depends from independent claim 13 and recites the additional features of "wherein the service means are arranged to encrypt the service-on-demand, and the registration means are arranged to include a key in the registration acknowledgement." Because the combination of Naddell and Pensak must teach, individually or combined, all the recitations of the base claim and any intervening claims of dependent claim 14, the arguments presented above supporting the patentability of independent claim 13 over Naddell are incorporated herein.

As will be discussed below, the cited prior art of Naddell and Pensak fail to disclose or suggest the elements of any of the presently pending claims.

Pensak generally describes a method for encrypting information for remote access while maintaining access control. However, Pensak fails to teach or suggest a system to offer service-on-demand as in the present invention. Pensak is silent as to teaching or suggesting, "Further, the combination of the cited references fail to teach or suggest, "registration means for receiving and acknowledging the registration of a user of the service-on-demand, and billing means responsive to the registration means for charging the user for the use of the service-on-demand," as recited in independent claim 13.

Clearly, Pensak does not resolve the deficiencies of Naddell. Thus, if as suggested by the Office Action, Pensak and Naddell are combined, a combination thereof would be silent as to providing an on-demand-service centre comprising "a service means for offering at least one service-on-demand," as recited in independent claim 13. The combination of the cited references would fail to teach or suggest the recitations of the registration means and the billing means recited in independent claim 13. In addition, Pensak and Naddell would fail to teach or suggest, "wherein the service means are arranged to encrypt the service-on-demand, and the registration means are arranged to include a key in the registration acknowledgement," as further recited in claim 14.

Furthermore, in the Office Action it is conclusively contended that "the motivation for doing so [to combine Pensak and Naddell] would be to make sure that the services provided are paid for by allowing only registered users to use the services." See bottom of page 4 of the Office Action. It appears that the Office Action is rejecting the claims using hindsight. However, Applicant respectfully asserts that using hindsight to combine the cited references is improper. "To support the conclusion that the claimed combination is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed combination. It is to be noted that simplicity and hindsight are not proper criteria for resolving the issue of obviousness." Ex Parte Clapp, 227 USPQ 972, 973 (B.P.A.I. 1985).

Specifically, the Office Action must explain the reasons that one of ordinary skill in the art would have been motivated to select the reference and to modify such reference to render the claimed invention obvious. For instance, "[r]ejection of patent application for obviousness under 35 USC §103 must be based on evidence comprehended by language of that section, and search for and analysis of prior art includes evidence relevant to finding of whether there is teaching, motivation, or suggestion to select and combine references relied on as evidence of obviousness; factual inquiry whether to combine references must be thorough and searching, based on objective evidence of record." In re Lee, 61 USPQ2d 1430 (CA FC 2002)

Thus, as pointed out in In re Lee, the record must support motivation, i.e., there must be something in the record pointing out where the recited motivation can be found. In addition, there must be some discussion on how that purported motivation or suggestion is even relevant to the reference being modified.

The outstanding rejection would appear to have taken the teachings of the present invention and applied the same to provide a combination of Pensak and Naddell, as set forth in the Office Action, to then disclose the presently claimed invention. Applicant respectfully asserts that the prima facie burden has not been met.

In the Office Action, at page 4, item numbered 5, claims 16 and 17 were rejected under 35 U.S.C. § 103 as being unpatentable over Naddell. The Office Action took the position that Naddell discloses all the aspects of claims 16 and 17. The rejection is traversed and reconsideration is requested.

Independent claim 16, upon which claim 17 depends, recites base transceiver station comprising channels for at least one cell, one of the channels being a cell-specific broadcast channel for transmitting general information to mobile stations in the cell, the base transceiver station being arranged to transmit at least one service-on-demand over one of its channels, the channel being other than the cell-specific broadcast channel for general information, the service-on-demand being available on said other channel to all mobile stations located in the cell.

As will be discussed below, the cited prior art of Naddell fails to disclose or suggest the elements of any of the presently pending claims.

As previously indicated and contrary to the contentions made in the Office Action, Naddell is silent as to teaching or suggesting providing service-on-demand in a communication system. None of the services described in Naddell are service-on-demand. Thus, Naddell fails to teach or suggest, "the base transceiver station being arranged to transmit at least on service-on-demand over one of its channels," as recited in

independent claim 16. In addition, the Office Action correctly recognized that Naddell fails to teach or suggest, "the channel being other than the cell-specific broadcast channel for general information," as recited in independent claim 16.

Naddell appears to describe that service information is transmitted on RF communication resources known to the communication units. See column 1, line 65, to column 2, line 5. However, the cited reference is silent as to how the service is transmitted to the communication units.

Naddell appears to also describe at least one communication unit that determines, from information, available service. See column 2, lines 12-32. The at least one communication unit displays an indication of the available services. However, Naddell does not teach or suggest transmitting general information using a channel other than the at least one communication unit. Thus, a person of ordinary skill in the art would use a dedicated control channel for broadcasting, according to the description provided in Naddell. Thus, Naddell fails to teach or suggest all the recitations recited in independent claim 16 and related dependent claim 17.

In view of the foregoing, it is respectfully requested that independent claim 16 and related dependent claim 17 be allowed.

CONCLUSION:

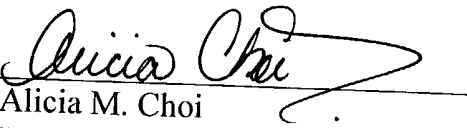
In view of the above, applicant respectfully submits that the claimed invention recites subject matter which is neither disclosed nor suggested in the cited prior art. Applicant therefore respectfully requests that each of claims 13 and 14 be found allowable and, along with allowed claims 1-12, this application passed to issue.

If for any reason the Examiner determines that the application is not now in condition for allowance, it is respectfully requested that the Examiner contact, by telephone, the applicant's undersigned attorney at the indicated telephone number to arrange for an interview to expedite the disposition of this application.

In the event this paper is not being timely filed, the applicant respectfully petitions for an appropriate extension of time.

Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,


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Enclosure: Petition for Extension of Time (1 month)